

AT 12632

PTO/SB/21 (09-04)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/065,022	
	Filing Date	09/11/2002	
	First Named Inventor	Michael Chiapperini	
	Art Unit	2632	
	Examiner Name	Nguyen, Phung	
Total Number of Pages in This Submission	16	Attorney Docket Number	02-087-MC

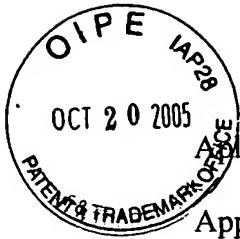
ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Return Receipt Postcard
<div>RECEIVED OCT 25 2005 TECHNOLOGY CENTER 2800</div>		
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	Lambert & Associates		
Signature	<i>Patrick D Archibald</i>		
Printed name	Patrick D. Archibald		
Date	10/18/2005	Reg. No.	52,464

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:			
Signature	<i>Patrick D Archibald</i>		
Typed or printed name	Patrick D. Archibald	Date	10/18/2005

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Appl. No. : 10/065,022
Applicant : Michael Chiapperini
Filed : September 11, 2002
TC/A.U. : 2632
Examiner : Nguyen, Phung
Docket No. : 02-087-MC

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Sir:

Please find enclosed an Appeal Brief in support of the above-referenced application.

RECEIVED
OCT 26 2005
TECHNOLOGY CENTER 2800

REAL PARTY IN INTEREST

The real party in interest is Mr. Michael Chiapperini, as inventor and applicant.

RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-19 are pending in the application. Claims 1-19 have been finally rejected and are the subject of this appeal.

STATUS OF AMENDMENTS

No amendments have been filed subsequent to final rejection.

SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1

Claim 1 recites a personal safety device comprising: a housing member; a repellent spray member housed inside of the housing member; a sound generating member housed inside of the housing member; means for activation of the repellent spray member and means for activation of the sound generating member.

Claim 4

Claim 4 recites the limitation of simultaneous activation of the spray and sound members.

Claim 5

Claim 5 recites the limitation of selective activation of the spray or sound member.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Rejection Under 35 U.S.C. 102

The examiner has rejected claims 1-3, 9, 13 and 16 under 35 U.S.C. 102(b) as being anticipated by Roberts, U.S. Patent No. 5,086,377 (hereinafter "Roberts").

Rejection Under 35 U.S.C. 103(a)

The examiner has rejected claims 4, 7, 8, 10, 11, 14, 15, 17 and 18 under 35 U.S.C. 103(a) as being unpatentable over Roberts in view of Malone, et al., U.S. Patent No. 5,859,588 (hereinafter "Malone").

The examiner has rejected claims 5 and 6 as being unpatentable under 35 U.S.C. 103(a) over Roberts in view of Keeter, U.S. Patent No. 5,867,099 (hereinafter "Keeter").

ARGUMENT

Rejections under 35 U.S.C. 102

Regarding claim 1: The examiner has improperly relied upon an inference that Roberts discloses a single housing member. Final Office Action of 05/16/05, Paragraph 2. In fact, Roberts discloses two housing members separated by a grip member. Roberts, Fig. 1; col. 4, lines 5-8 and lines 29-33. The grip functions as an additional housing, specifically retaining the spray member. Roberts, Fig. 7; col. 3, lines 1-15. Therefore, Roberts fails to disclose a single housing that retains both the spray and sound generating members. As a result, each and every element claimed by applicant is not disclosed by Roberts. Accordingly, there can be no anticipation based on 35 U.S.C 102(b).

Regarding claims 2, 3, 9, 13 and 16: These claims properly depend from claim 1. Because claim 1 is not anticipated by Roberts, the claims depending from claim 1 likewise can not be anticipated by Roberts.

Rejections under 35 U.S.C. 103

Regarding claim 4: The examiner has failed to allege that Roberts teaches the elements of claim 1, from which claim 4 depends. This is fatal to the examiner's argument that claim 4 is anticipated by a combination of Roberts and Malone.

Further, although Malone discloses a means for simultaneous activation of the spray and sound generating members, such teaching cannot be combined with Roberts in any meaningful way. There is no way for a skilled artisan to employ the teaching of Malone in the system of Roberts without undue experimentation, or excessive modification of the Roberts device. The device of Roberts is specifically equipped with grips that ready the hand of the user to activate the spray member: "once the device is properly grasped, the user's thumb, as shown in FIG. 6, will be immediately positioned on the aerosol actuator slide switch 40." Roberts, col. 3, lines 31-33. This limitation prevents the addition of the switch of Malone from being added to the device of Roberts. Therefore, the combination of Malone and Roberts can not render applicant's device obvious.

Regarding claim 7: The examiner has merely repeated that Malone discloses an actuator integrated with the housing member. As previously argued by applicant, Malone discloses a separate handle, in addition to the handbag (cited by the examiner as the

"housing" of Malone). The actuating means disclosed by Malone is "located in a handle of the handbag." Malone, col. 4 lines 6-8. Applicant's invention claims an actuator that is integrated with the housing member, not in a peripheral component, such as a handle. Although the handle of the handbag disclosed by Malone may be connected to the handbag, it can not be said that this indirect connection integrates the actuator within the handbag. As a result, Applicant's claim 7 is not rendered obvious by the combination of Malone and Roberts because the actuator disclosed by Malone is not integrated with the housing member.

Regarding claim 8: The examiner has failed to establish a prima facie case of obviousness with respect to claim 8. The examiner has stated that Malone discloses that the repellant is a noxious gas. However, the citation that the Examiner notes (col. 2, lines 16-18) reads as follows: "a chamber 19 is located at the base of the handle distal end. This chamber 18 opening allows a pepper spray stream to pass." Nowhere in Malone is there reference to a "noxious gas," or of any type of gas at all. Malone et al. claims, and the specification supports, only the use of "pepper spray." Various citations on the Internet may be found discussing the make-up of pepper spray. The following description is one example:

OC is oleoresin capsicum, which is extracted from chili peppers and is commonly called Pepper Spray. This product is the most widely sold today and the spray of choice for police since 1977. Pepper spray is generally regarded to be the most distressing to experience, but it must be sprayed directly in the eyes or inhaled to be effective. *The product is an oily liquid* not very soluble in water. McGoe, Chris E., http://www.crimedocter.com/self_defense_1.htm, Last Updated 4/30/2004 (emphasis added).

A similar definition can be found in the dictionary that defines "pepper spray" as:
"a nonlethal aerosol spray made with the pepper derivative oleorsein capiscum; used to cause temporary blindness and incapacitate an attacker; also used as a bear deterrent."

<http://wordnet.princeton.edu/cgi-bin/webwn2.0?stage=1&word=pepper+spray>, Wordnet A Lexical Database For the English Language, Last Visited June 01, 2004.

Therefore, it is seen that pepper spray is not a gas at all, but a liquid. As a result, contrary to the examiner's assertion, Malone et al. does not disclose that the repellent is a noxious gas. Accordingly, Applicant's claim 8 is not anticipated by Malone et al. and should be allowed.

Regarding claims 10 and 11: The examiner has also rejected claims 10 and 11 as being anticipated by the disclosure of Malone and Roberts. Because the two claims and respective rejections are closely connected, both will be dealt with simultaneously to avoid repetitious argument. The examiner does not explain how Roberts contributes to a finding that applicant's invention is obvious, therefore applicant contends that a prima facie case of obviousness has not been properly made.

The examiner's rejections of claims 10 and 11 both state that the Malone discloses a sound generating member comprised of a compressed gas container coupled to a horn and a whistle, respectively. However, nowhere in the examiner's citation (col. 2, lines 25-44) is there reference, explicitly or implicitly, to either compressed gas, whistles or horns. Malone discloses merely an "air siren canister," an "air siren," and a "piercing sound." Malone et al. at col. 2 lines 25-44. Applicant's sound generating member contains such details in the specification as "a compressed gas container 8

coupled to a horn 9 via a second tube.” Applicant’s Detailed Description para. 17. Malone does not disclose the use of a second tube, nor does it disclose a compressed gas container coupled to a horn. Regardless of how the air siren of Malone generates its “piercing sound,” it does not disclose the specific limitations found in applicant’s invention. Therefore, Malone can not be said to anticipate applicant’s claim 10. The same arguments are equally applicable to applicant’s claim 11, substituting a whistle for the horn. Accordingly, neither claim 10 nor claim 11 are anticipated by the combination of Malone and Roberts, and should be allowed.

Regarding claims 14, 15, 17 and 18: The arguments made with reference to claims 4, 8, 10 and 11 above, are similarly applicable to claims 14, 15, 17 and 18.

Regarding claims 5 and 6: The examiner has not established a prima facie case of obviousness because no substantive response was given to applicant's arguments. The examiner changed the previous rejection of claim 5 by merely substituting Roberts in place of Malone and Hartley. In the first office action the examiner noted that "Malone and Hartley do not teach the actuator has means for selectively activating the repellant spray member as claimed." Office Action of 08/25/2004, Paragraph 3. The examiner went on to allege that the addition of Keeter would then render applicant's invention obvious.

In the Final Office Action, the examiner merely states that "Roberts does not disclose the actuator has means for selectively activating the repellant spray member as

claimed." Office Action of 5/16/2005, Paragraph 5. The examiner then goes on to repeat the previous argument that the addition of Keeter renders applicant's invention obvious.

The examiner has merely replaced two references (Malone and Hartley) that fail to disclose relevant limitations, with a single reference (Roberts) that also fails to disclose any relevant limitations. This substitution coupled with a repetition of why the switch of Keeter renders applicant's invention obvious is not sufficient to rebut applicant's arguments.

Applicant has previously noted that the examiner cites Keeter as disclosing a three position mini-slide switch that would enhance the system of Malone by giving the user an option of selecting the particular mode, as desired. Substituting Roberts for Malone, the examiner concludes that the combination of Roberts and Keeter would render Applicant's invention obvious. Unlike the previous argument, the Examiner does not argue that substituting the switch 28 of Keeter with a specific switch of Roberts will render Applicant's invention obvious. This is likely due to the fact that Roberts includes a number of switches, and therefore a substitution would not result in a operable device.

The switch of Keeter referenced by the Examiner is a "three position double pole mini-slide switch." Keeter at col. 4 lines 17-18. As disclosed by Fig. 6, the switch disclosed by Keeter is part of an electrical circuit that when closed, will complete the circuit for either the lights, the audible alarm, or both. Keeter at Fig. 6.

The switch disclosed by Applicant's invention is a manually operated, slidable switch that requires the physical depression of an actuator pad. Chiapperini, U.S. Pat. Appl. No. 10/065,022 para. 17 and Fig. 1. The switch disclosed by Applicant will result

in the depression of subsequent actuator pads that actuate either spray, sound, or both simultaneously. Chiapperini at para. 17 and Fig. 1.

It should be clear that substituting the switch of Keeter for any of the switches of Roberts will result in a personal protection device that is inoperable. A device resulting from the combination of two or more patents that results in an inoperable product can not be said to render Applicant's invention obvious. Keeter may teach the idea of a switch that can operate multiple devices, but this idea is not one that can be combined with the device of Roberts, either theoretically or physically. Therefore, the combination of Roberts and Keeter will not produce a combined teaching that will result in making Applicant's invention obvious to one of ordinary skill in the art at the time the invention was made. As a result, claims 5 and 6 are not unpatentable under 35 USC 103(a) in light of Roberts in view of Keeter.

Regarding claims 12 and 19: Similar to the rejection of claims 5 and 6 above, the examiner has substituted Roberts as a non-teaching reference, for Malone and Hartley as a non-teaching combination. The examiner then argues that Masi teaches the missing elements necessary to arrive at a finding of anticipation. As a preliminary matter, applicant asserts that a prima facie showing of obviousness has not been shown as applicant's arguments have not received a substantive response.

Applicant's invention as disclosed in claims 12 and 19, claims a sound generating member that "has means for emitting sounds waves that are audible to animals and not audible to humans." Chiapperini at Claims 12 and 19.

The key difference between the teaching of Masi and applicant's invention is that Masi only teaches a high pitched frequency, not a sound that is audible to animals and inaudible to humans. The sound waves emitted by applicant's invention may or may not be a high pitched frequency, the only limitation is that it be audible to animals and not to humans. Masi does not teach a device that emits sound waves that are inaudible to humans. The high pitched frequency disclosed by Masi could deter dogs while still being audible to humans. Masi does not disclose any type of instruction as to how high a frequency would suffice to deter dogs, nor does Masi indicate whether the high pitched frequency would be within the hearing range of humans or not. As a result, the only thing that Masi has in common with applicant's invention with respect to the sound waves is that they are emitted from the device. Therefore, a significant difference exists between the sound waves emitted from the two devices; and this difference is so significant that it removes any possibility that Applicant's invention could be rendered obvious under 35 USC 103.

For the reasons advanced above, Applicant respectfully contends that each Claim is patentable. Therefore, reversal of all rejections is courteously solicited.

Respectfully Submitted,

10/18/2005
Date

Patrick D. Archibald
Patrick D. Archibald
Attorney for Applicant
Reg. No. 52,464

Patrick D. Archibald
Lambert & Associates
92 State Street
Boston, MA 02109
Tel. (617) 720-0091

CLAIMS APPENDIX

Claim 1 A personal safety device comprising:

a housing member, wherein said housing member comprises a design not intended to mask the function of said personal safety device;

a repellant spray member housed inside of the housing member; a sound generating member housed inside of the housing member; means for activation of the repellant spray member, wherein upon activation of the repellant spray member a repellant stored inside of the repellant spray member is released from the repellant spray member; and means for activation of the sound generating member, wherein upon activation of the sound generating member a sound is emitted from the sound generating member.

2. The personal safety device of claim 1 wherein: the housing member has a first aperture for allowing release from the housing member of the repellant when the repellant spray member is activated.

3. The personal safety device of claim 1 wherein: the housing member has a second aperture for allowing emission from the housing member of the sound when the sound generating member is activated.

4. The personal safety device of claim 1 further comprising: means for simultaneous activation of the repellant spray member and the sound generating member.

5. The personal safety device of claim 1 further comprising: an actuator, integrated with the housing member, wherein the actuator has means for selectively activating the repellant spray member.

6. The personal safety device of claim 1 further comprising: an actuator, integrated with the housing member, wherein the actuator has means for selectively activating the sound generating member.

7. The personal safety device of claim 1 further comprising: an actuator, integrated with

the housing member, wherein the actuator has means for simultaneous activation of the repellent spray member and the sound generating member.

8. The personal safety device of claim 1 wherein: the repellent is a noxious gas.

9. The personal safety device of claim 1 wherein: the repellent is a mixture of noxious gases.

10. The personal safety device of claim 1 wherein: the sound generating member is comprised of a compressed gas container coupled to a horn.

11. The personal safety device of claim 1 wherein: the sound generating member is comprised of a compressed gas container coupled to a whistle.

12. The personal safety device of claim 1 wherein: the sound generating member has means for emitting sound waves that are audible to animals and not audible to humans.

13. A personal safety device comprising: a housing member, wherein said housing member comprises a design not intended to mask the function of said personal safety device, and wherein said housing member includes a first aperture and a second aperture; a repellent spray member housed inside of the housing member; a sound generating member housed inside of the housing member; an actuator, integrated with the housing member, wherein the actuator has: means for activation of the repellent spray member, wherein upon activation of the repellent spray member a repellent stored inside of the repellent spray member is released from the repellent spray member, and further released from the housing member via the first aperture; and means for activation of the sound generating member, wherein upon activation of the sound generating member a sound is emitted from the sound generating member, and further release from the housing member via the second aperture.

14. The personal safety device of claim 13 wherein: an actuator has means for

simultaneous activation of the repellant spray member and the sound generating member.

15. The personal safety device of claim 13 wherein: the repellant is a noxious gas.

16. The personal safety device of claim 13 wherein: the repellant is a mixture of noxious gases.

17. The personal safety device of claim 13 wherein: the sound generating member is comprised of a compressed gas container coupled to a horn.

18. The personal safety device of claim 13 wherein: the sound generating member is comprised of a compressed gas container coupled to a whistle.

19. The personal safety device of claim 13 wherein: the sound generating member has means for emitting sound waves that are audible to animals and not audible to humans.

EVIDENCE APPENDIX

The following is the evidence (patents and patent application) submitted by the examiner and applicant and relied upon by appellant in the appeal.

5,086,377	Roberts	2-1992
5,517,180	Masi, et al.	5-1996
5,859,588	Malone, et al.	1-1999
5,867,099	Keeter	2-1999

<http://wordnet.princeton.edu/cgi-bin/webwn2.0?stage=1&word=pepper+spray>,

Wordnet A Lexical Database For the English Language, Last Visited June 01, 2004.

McGoey, Chris E., http://www.crimedoctor.com/self_defense_1.htm, Last Updated 4/30/2004

RELATED PROCEEDINGS APPENDIX

There are no decisions rendered by a court or the Board in any proceeding as noted in the section titled: RELATED APPEALS AND INTERFERENCES.